



ATTACHMENT A

Remarks

Claims 1-3, 6, 8-16, 18, 22, 23 and 32-34 have been rejected under 35 USC 103(a) as being "unpatentable over" a combination of the Thomas, Irvin and Takahashi references. This rejection is respectfully traversed. First, it is assumed that the Examiner intended to refer to claims 1-3, 6, 8-16, 18, 22, 25-28, 32-34 and 36-40 (as set forth on page 10 of the Office Action) since all of these claims are treated in the current Office Action.

Turning now to the individual claims, in the rejection of independent claim 1, the Examiner admits that "Thomas fails to disclose identification codes for each of said compatible devices being preprogrammed into the cellular telephone." However, the Examiner argues that "Irvin teaches identification codes for each of said compatible devices being pre-programmed into the cellular telephone so as to enable a name of a person to be associated with each said compatible device (FIG. 4 and column 6, lines 48-64)." The Examiner argues that "[t]herefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Thomas using the teaching of multiple entry phonebooks as taught by Irvin." The Examiner attempts to support this argument by concluding that this "modification of the invention enables the system to disclose identification codes for said compatible devices being preprogrammed into the cellular telephone so that the user would organize the names and number of the conference participants."

The Irvin patent discloses a wireless communications terminal including a first transducer that communicates with a first wireless communications system such as a cellular communications system and a second transducer that communicates with a second wireless communications system such as a bluetooth or FRS system. A multiple entry phonebook includes a first wireless communication system access number and a second wireless communication access number for each of one or more entities. The multiple-entry phonebook is indicated at 400 in Figure 4, referred to by the Examiner, and the passages at column 6, lines 48-65, also referred to by the Examiner, provide that identification 405 may comprise an entity number, names or other identification.

It is respectfully submitted that the mere fact that multiple entry phonebooks exist in the prior art, as evidenced by the Irvin reference, does not mean that it would be obvious to incorporate such a phonebook into the Thomas system. Thomas is concerned with a method and apparatus for setting up a conference call in which one of a group of communication devices connected to a low power radio frequency (LPFR) network is able to set up a call to a party external of the network, and involves the use of both a PLLN 4 and the LPFR network. In contrast, Irvin is simply concerned with a phonebook for first and second different types of wireless systems for assisting a user in placing a call using either system. Thus, it is respectfully submitted that the stated motivation ("so that the user would organize the names and numbers of the conference participants") is not based on the teachings of either reference, and that the proposed combination is necessarily the improper product of hindsight.

The Examiner also admits that "Thomas fails to disclose the cellular telephone further comprising a microphone and speaker coupled to the mixer such that sound generated at the microphone is not played at the speaker." However, the Examiner contends that "Takahashi teaches a cellular telephone further comprising a microphone and speaker coupled to the mixer such that sound generated at the microphone is not played at the speaker (FIG. 1 and column 7, lines 24-27)." The Examiner states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Thomas using the teaching of the microphone as taught by Takahashi." The Examiner also contends that "[t]his modification of the invention enables the system to disclose the cellular telephone further comprising a microphone and speaker coupled to the mixer so that the user would transmit a voice communication through network."

Figure 1 of Takahashi merely shows a block diagram "showing a general configuration of a mobile device constituted by applying the incoming call control method and device for a mobile communication device" according to the invention disclosed in the patent. Lines 24-27 of column 7 state that: "A sound signal input via the microphone 16 is transmitted via the audio section 14, modulator section 17, mixer 19, amplifier 20, duplexer 11 and antenna 10 to the base station 200, in the form of a radio signal." It is respectfully submitted that neither Figure 1 nor these lines of column 7 are

a teaching of the feature in question. Moreover, it is respectfully submitted that the reasons stated in support of the obviousness of the combination of Thomas and Takahashi are not based on anything actually taught in either of the references. Thus, it is respectfully submitted that the proposed combination would not result in the present invention as claimed in claim 1 and that, moreover, the proposed combination is the improper product of hindsight, given the actual teachings of the Thomas and Takahashi references.

Turning to independent claim 11, this claim recites, inter alia, using a second transceiver to broadcast a request for compatible third party devices within a desired local area to identify themselves, generating a list of the devices responding to the request, and selecting at least one third party device from the list.

In rejecting claim 11, the Examiner admits that Thomas "fails to disclose generating a list of third party devices responding to the request and selecting of at least one third party device from the list." However, the Examiner contends that "Irvin teaches generating a list of the third party devices responding to the request (FIG. 4 and column 6, lines 48-65); and selecting of at least one third party device from the list (FIG. 4 and column 6, lines 48-65)." The Examiner concludes that "it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Thomas using the teaching of multiple entry phonebooks as taught by Irvin" and further contends that this "modification of the invention enables the system to disclose identification codes for said compatible devices being preprogrammed into the cellular telephone so that the user would organize the names and numbers of the conference participants."

It is respectfully submitted that the lines in question of column 6 and the showing in Figure 4 are simply not a teaching of using a second transceiver to broadcast a request for compatible third party devices within a local area network to identify themselves and then generating a list of devices responding to the request. The teachings of the Irvin patent with respect to a multiple entry phonebook have been discussed above. In any event, the disclosure in Irvin of a multiple entry phonebook is clearly not a teaching of the subject matter of claim 11. Hence, claim 11 patentably defines over the combination of Thomas and Irvin for at least this reason. Moreover, it

is respectfully submitted that the supporting arguments made in the Office Action with respect to a multiple entry phonebook and quoted above relate to claims such as claims 1 and 25 and not to claim 11.

Independent claim 18 includes a limitation similar to that discussed above in connection with claim 11 and, in this regard, provides that the method further comprises "identifying compatible third party devices by broadcasting a request for compatible third party devices in the range of the local area receiver to identify themselves and adding to the menu third party devices responding to the request." Again, this feature patentably defines over the proposed combination even assuming for the sake of argument that that combination is a proper one.

Finally, with respect to independent claim 25, this claim distinguishes over the prior art for the reasons discussed above in connection with the "microphone-speaker" feature of claim 1, i.e., a microphone coupled to the combining means and a speaker coupled to the combining means such that sound generated at the microphone is not generated at the speaker. Further, a number of the claims dependent on claim 25 are separately patentable. For example, dependent claim 37 sets forth features similar to those discussed above with respect to claim 1, and new dependent claim 41 recites features similar to those discussed above with respect to claims 11 and 18.

Allowance of the application in its present form is respectfully solicited.

END REMARKS